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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,778

09/30/2003

Jerry Waikit Tsui

CA920020061US1

4447

57736

7590

12/24/2008

PATENTS ON DEMAND, P.A. IBM-RSW

4581 WESTON ROAD

SUITE 345

WESTON, FL 33331

EXAMINER

RANKINS, WILLIAM E

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

12/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/674,778	<b>Applicant(s)</b> TSUI ET AL.	
	<b>Examiner</b> WILLIAM E. RANKINS	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                       |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 09/30/2003 and 02/14/2008 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Status of Claims***

Claims 1-20 are pending in this application. Claims 1, 6, 11 and 16 are amended and claims 18-20 are new.

### ***Response to Arguments***

1. Applicant's arguments, see pg. 10, filed 10/01/2008, with respect to 17-20 have been fully considered and are persuasive. The objection of 08/19/2008 has been withdrawn.
2. Applicant's arguments, see pg. 11, filed 10/01/2008, with respect to claims 17-20 have been fully considered and are persuasive. The 112 2nd rejection of 08/19/2008 has been withdrawn.

Art Unit: 3696

3. Applicant's arguments, see pg. 10, filed 10/01/2008, with respect to claims 17-20 have been fully considered and are persuasive. The 101 rejection of 08/19/2008 has been withdrawn.

4. Applicant's arguments filed 10/01/2008 have been fully considered but they are not persuasive. Claims 2, 7 and 12 were rejected under 112 2nd for being indefinite. The claimed subject matter was not further defined by the amended claim or the specification.

5. Applicant's arguments, see pg. 13, filed 10/01/2008, with respect to claims 1-15 and 18-20 have been fully considered and are persuasive. The warning of objection of 08/19/2008 has been withdrawn.

6. Applicant's arguments, see pgs. 11-14, filed 10/01/2008, with respect to the rejection(s) of claim(s) 1-20 under 35 USC § 102(b) and § 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of AXS-ONE LAUNCHES WEB SERVICES FOR SERVICES INDUSTRIES Worldwide Videotex Update. Boston: Apr 1, 2002. Vol. 21, Iss. 4.

Note: The examiner rejects the assertion by applicant that web services were not contemplated or known in the field of computer science when Robohm was conceived/filed. See Bellinger (2002/0169858).

A review of the claims and updated search necessitated the rejections below.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 2, 7 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. the claim to "additional" billing functions without specifically disclosing the additional billing functions is preemptive and attempts to cover every substantial practical application of billing functions.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 2, 7 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robohm et al. (2002/0138828) in view of Videotex (AXS-ONE LAUNCHES WEB SERVICES FOR SERVICES INDUSTRIES Worldwide Videotex Update. Boston: Apr 1, 2002. Vol. 21, Iss. 4).

As per claim 1:

Robohm discloses:

A software system digitally encoded in at least one machine readable medium configured to usable by at least one machine for use in a billing service, wherein a plurality of first billing functions is provided by said billing service to computing applications residing on one or more computing devices in a distributed network, the software system comprising (Para. 0008 and 0057):

a. an interface defined for a billing service, said interface being adapted for coupling to a billing engine, said billing engine residing on a computing device in said

Art Unit: 3696

distributed network and being adapted to perform said plurality of first billing functions, said interface comprises a plurality of application programming interfaces, each of said application programming interfaces being associated with a first billing function and being implemented such that the first billing function associated therewith is performed after a web service invocation that commands performance of said first billing function is received by said web service interface (Para's. 0008, 0034 and 0035, Figs. 3, 13, 14 and 20-27); and

b. a plurality of object classes, each of said object classes defining objects for storing data utilized by said billing engine and for communicating said data to said billing engine through at least one interface, said interface being used to provide said billing in a network (Fig. 13).

Robohm does not disclose:

Providing a web service interface for a billing service in a distributed network;

However;

Videotex discloses that AXS-One launched a web service for services industries to assist in billing, collections, etc. AXS-One's web services allow applications to share services and exchange information (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Robohm and Videotex to provide e-business solutions to allow companies to quickly create new products and services by extending the reach of internal business systems, thus creating efficient and highly optimized value chain based business solutions.

Art Unit: 3696

Additionally, KSR exemplary rationale A which provides for combining prior art elements according to known methods to yield predictable results.

As per claim 2;

Robohm et al. discloses:

The software system as claimed in claim 1, wherein said interface is extendable to provide said computing application with additional billing functions, and said billing engine is adapted to perform said additional billing functions (Para. 0044).

Claims 3-5 are similarly rejected by the recitation provided for claim 2.

Claims 6-16 are similarly rejected by the recitation provided for claim 1-5.

2. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robohm et al. (2002/0138828) in view of How to get started with server-side java (Jason Hunter, Java World.com, 03/01/97 and Tsui et al. (2004/0066411) and Videotex (AXS-ONE LAUNCHES WEB SERVICES FOR SERVICES INDUSTRIES Worldwide Videotex Update. Boston: Apr 1, 2002. Vol. 21, Iss. 4).

As per claim 17;

Robohm does not disclose:



The use of a billing service, as claimed in claim 16, wherein the first billing functions of said billing service are performed by a server-side billing engine, and wherein the Web service interface is a client side interface, wherein the Web service is a well-defined, self-contained component that encapsulates specific functionality, which is made available to other computing applications over a network by web service invocation using a Simple Object Access Protocol (SOAP).

However, Hunter discloses:

Server side Java as platform independent and object oriented (pg. 1).

Tsui discloses:

A known solution for integrating heterogeneous internet based applications or services...the concept 'web service' (Para. 0005).

And Videotex discloses the web services solution(see claim 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Robohm, Hunter and Tsui and Videotex. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to reduce start up delays and maintain state between executions. Additionally, Tsui admits that web service is old and well known. The rationale provided for claim 1 also applies.

Claims 18-20 are rejected under the same rationale used to reject claim 17.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William E Rankins/  
Examiner, Art Unit 3696  
12/19/2008

/Daniel S Felten/  
Primary Examiner, Art Unit 3696